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REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 10-17 were rejected under 35 USC § 112, second paragraph, as being indefinite. According to the Examiner, there is insufficient antecedent basis for the phrase "previously scanned" in claim 10. Applicants respectfully submit that such phrase does not require antecedent basis as it does not contain "the" or "said" or anything else to suggest that there is a recitation to it somewhere previously in the claim. Nevertheless, in order to advance the prosecution, Applicants have added step (0) to claim 10. Applicants believe this amendment overcomes this issue. If not, then in the next Office Action, Applicants would appreciate a suggestion from the Examiner how this rejection might be overcome.

Claims 10, 13-15, 17 and 18 were rejected under 35 USC § 103(a) as being obvious over Jordan, US 6,152,731, in view of Poirier, US 2002/0102517.

Claim 11 was rejected under 35 USC § 103(a) as being obvious over Jordan in view of Poirier and further in view of Baumrind, US 6,621,491.

Claim 12 was rejected under 35 USC § 103(a) as being obvious over Jordan in view of Poirier and further in view of Chishti, US 5,975,893.

Claim 16 was rejected under 35 USC § 103(a) as being obvious over Jordan in view of Poirier and further in view of Brodkin, US 2002/0033548.

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In response to *all four* obviousness rejections, Applicants respectfully submit again that the cited combination of references does not make out a *prima facie* case of obviousness.

In the middle of page 8 of the amendment dated October 12, 2006, Applicants pointed out that Jordan failed to teach instant steps (e), (f), (j), (k), (l) and (m). Although the Examiner makes new grounds of rejection, the Examiner still fails to show where in Jordan alone or in combination with the other cited references, instant steps (e), (f), (j), (k), (l) and (m) are taught or suggested.

While the Examiner is correct that Poirier makes a scan of dentures, these are the patient's own custom made dentures and, thus, represent *the existing state* of the patient's oral cavity. Thus, according to Poirier's Figure 5, images are made both of the gum surface "of reference" and the false teeth "of reference." A person of ordinary skill in the art would understand "of reference" means "of the patient."

In other words, Poirier's scan is not a scan of extraneous artificial teeth to be introduced into a virtual model of a patient's oral cavity to make a dental model. Consequently, the combination of Jordan and Poirier does not make out a *prima facie* case of the obviousness of the present claims.

The instant claims require recording fabricated teeth and separately recording the oral cavity, preparing a virtual model of the oral cavity and then placing the scanned fabricated teeth into the virtual model. Poirier uses data from a patient's own custom made dentures to determine the optimal position in that patient's jaw *for a drill hole for*

an implant. There is no motivation for a person skilled in the art to scan such a denture for the purpose of placing it into a virtual model of the oral cavity of a patient already fitted for the denture for the purpose of preparing a dental prosthesis for use in a patient already fitted for the denture.

In short, the combination of Jordan and Poirier is hopelessly strained. Moreover, the other secondary references do not ameliorate this problem. Consequently, none of the combinations make out a *prima facie* case of the obviousness of the instant claims.

In view of the foregoing, Applicants respectfully submit that the Examiner would be fully justified to reconsider and withdraw all of the obviousness rejections. An early notice that all of the obviousness rejections have been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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